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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,212	11/16/2001	Preeti Lal	PF-0221-3 DIV	9736

7590 05/31/2002

INCYTE GENOMICS, INC.  
PATENT DEPARTMENT  
3160 Porter Drive  
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[REDACTED] EXAMINER

STEADMAN, DAVID J

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

1652

DATE MAILED: 05/31/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/991,212	LAL ET AL.
	Examiner	Art Unit
	David J. Steadman	1652

-- The MAILING DATE of this communication appears in the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,3-7,9-16,28,29,46-48 and 57 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_ is/are allowed.  
 6) Claim(s) \_\_\_\_ is/are rejected.  
 7) Claim(s) \_\_\_\_ is/are objected to.  
 8) Claim(s) 1,3-7,9-16,28,29,46-48 and 57 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 11) The proposed drawing correction filed on \_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.  
 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.  
 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) The translation of the foreign language provisional application has been received.  
 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____.<br> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)              | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)     |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.<br> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Application Status***

Claims 1, 3-7, 9-16, 28, 29, 46-48, and 57 are pending in the application.

Cancellation of claims 2, 8, 17-27, 30-45, and 49-56 in a preliminary amendment filed 11/16/01 is acknowledged.

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claim 1, drawn to the human sodium-dependent phosphate cotransporter (NAPTR) polypeptide of SEQ ID NO:1, classified in class 530, subclass 350.
  - II. Claims 3-7, 9, 10, 12, 13, 46, 48, and 57, drawn to the polynucleotide of SEQ ID NO:2, a polynucleotide encoding the NAPTR polypeptide of SEQ ID NO:1, a host cell, a method of producing a polypeptide, and a microarray, classified in class 435, subclass 69.1.
  - III. Claim 11, drawn to antibody that binds a NAPTR polypeptide, classified in class 530, subclass 387.9.
  - IV. Claims 14-16, drawn to methods for detecting a target polynucleotide by hybridization or PCR, classified in class 435, subclass 6.
  - V. Claim 28, drawn to a method for screening a compound for effectiveness in altering expression of a polynucleotide, classified in class 435, subclass 6.
  - VI. Claim 29, drawn to a method of assessing toxicity of a test compound using a probe, classified in class 435, subclass 6.
  - VII. Claim 47, drawn to a method of generating a transcript image of a sample using a microarray, subclass 6.
2. The inventions are distinct, each from the other because:

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3. The polypeptide of Group I, the polynucleotide of Group II, and the antibody of Group III each comprises a chemically unrelated structure capable of separate manufacture, use and effect. The polynucleotide of Group II comprises a nucleic acid sequence and the polypeptide of Group I and the antibody of Group III each comprise an unrelated amino acid sequence. The polynucleotide of Group II has other utility besides encoding polypeptides such as a hybridization probe, the polypeptide of Group I has other utility besides generating antibodies such as applicants' assertion of a pharmaceutical composition for treatment of a disease, and the polypeptides can be produced by another method such as isolation from a natural source or chemical synthesis. The antibody of Group III have other utility besides being used as a detection reagent such as an affinity purification reagent for the polypeptide of Group I.

4. The polypeptide of Group I is unrelated to the method(s) of Groups IV-VII as it is neither used nor made by the method(s) of Groups IV-VII.

5. The polynucleotide of Group II and the methods of Groups IV-VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polynucleotide of Group II can be used for expression of the polypeptide of Group I.

6. The antibody of Group III is unrelated to the method(s) of Groups IV-VII as it is neither used nor made by the method(s) of Groups IV-VII.

7. The methods of Groups IV-VII are independent as they comprise different steps and yield different results.

8. Because these inventions are distinct for the reasons given above, have separate classifications, and/or each of the inventions listed as Groups I-VII **require a separate search** resulting in an undue burden on the Examiner, restriction for examination purposes as indicated is proper.

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9. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Steadman, whose telephone number is (703) 308-3934. The examiner can normally be reached Monday-Friday from 8:00 am to 4:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (703) 308-3804. The FAX number for this Art Unit is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Art Unit receptionist whose telephone number is (703) 308-0196.

David J. Steadman, Ph.D.



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PRIMARY EXAMINER  
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*6 WD*